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CERTIFICATE OF MAILING

I hereby certify that the below listed items are being deposited with the U.S. Postal Service as first class mail in an envelope addressed to:

**Mail Stop Amendment
Commissioner for Patents
P.O. Box 1450
Alexandria, Virginia 22313-1450**

on

1-24-05

Jeffrey R. Kuester

In Re Application of:

Lyles, et al.

Serial No.: 10/729,403

Filed: December 5, 2003

Confirmation No.: 9580

Group Art Unit: 2681

Examiner: Unassigned

Docket No.: 190250-1480

For: **Telecommunications Assignment System**

The following is a list of documents enclosed:

Return Postcard
Information Disclosure Statement
PTO-1449 - citing 2 references, one of which is incorporated into IDS
Cited Reference A

Further, the Commissioner is authorized to charge Deposit Account No. 20-0778 for any additional fees required. The Commissioner is requested to credit any excess fee paid to Deposit Account No. 20-0778.

Customer No.: **38823**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In Re Application of:

Lyles, et al.

Serial No.: 10/729,403

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INFORMATION DISCLOSURE STATEMENT

Mail Stop Amendment
 Commissioner for Patents
 P.O. Box 1450
 Alexandria, Virginia 22313-1450

Sir:

This information disclosure statement is filed in accordance with 37 C.F.R. §§ 1.56, 1.97, and 1.98, and specifically:

- ☒ under 37 CFR 1.97(b), or
 (within Three months of filing national application; or date of entry of international application; or before
 mailing date of first office action on the merits; whichever occurs last)
- ☐ under 37 CFR 1.97(c) together with either a:
☐ Statement Under 37 C.F.R. 1.97(e), or
☐ a \$180.00 fee under 37 CFR 1.17(p), or
 (After the CFR 1.97(b) time period, but before the final office action or notice of allowance, whichever
 occurs first)
- ☐ under 37 CFR 1.97(d) together with a:
☐ Statement under 37 CFR 1.97(e), and
☐ a \$180.00 petition fee set forth in 37 CFR 1.17(p).
 (Filed after final office action or notice of allowance, whichever occurs first, but before payment of the
 issue fee)

Enclosed is a check in the amount of \$. Please charge \$ to deposit account 20-0778. At any time during the pendency of this application, please charge any fees required to Deposit Account 20-0778 pursuant to 37 CFR 1.25. The Commissioner is hereby requested to credit any overpayment to Deposit Account No. 20-0778.

- ☒ Applicant(s) submit herewith *Form PTO 1449A - Information Disclosure Statement by Applicant* together with copies of patents, publications or other information of which applicant(s) are aware, which applicant(s) believe(s) may or may not be material to the examination of this application and for which there may be a duty to disclose in accordance with 37 CFR 1.56. As required by 37 C.F.R. §1.98(a), a legible copy of each document is provided.
- ☐ A concise explanation of the relevance of foreign language patents, foreign language publications and other foreign language information listed on PTO Form 1449, as presently understood by the individual(s) designated in 37 CFR 1.56(c) most knowledgeable about the content is given on the attached sheet, or where a foreign language patent is cited in a search report or other action by a foreign patent office in a counterpart foreign application, an English language version of the search report or action which indicates the degree of relevance found by the foreign office is listed on the form PTO 1449 and is enclosed herewith.

The following rights are reserved by the Applicant(s): the right to establish the patentability of the claimed invention over any of the listed documents should they be applied as reference, and/or the right to prove that some of these documents may not be prior art, and/or the right to prove that some of these documents may not be enabling for the teachings they purport

to offer.

This statement should not be construed as a representation that an exhaustive search has been made, or that information more material to the examination of the present application does not exist. Any statements or identifications regarding the relevance of any portion(s) of cited references should not be construed as a representation that the most relevant portion(s) have been identified, and the absence of such statements or identifications should not be construed as representations that there are no relevant portion(s). The Examiner is specifically requested not to rely solely on the materials submitted herewith. The Examiner is requested to conduct an independent and thorough review of the documents, and to form independent opinions as to their significance.

As cited in attached form PTO-1449, more than one year prior to December 5, 2003, Applicants made and used a telecommunications assignment system which operated as described in the document entitled "BTAS User Documentation." However, this document was only available to BellSouth employees and contractors. As such, the "BTAS User Documentation" document is not a printed publication. Instead, the document is only presented to show the state of the system more than 1 year prior to the filing date of the present application for the purpose of determining whether the invention was on sale or in public use more than 1 year prior to the filing date of the present application. Applicants respectfully assert that this does not comprise on-sale or public event because it was not used in the production of a product, to provide a service to customers, or in a public manner.

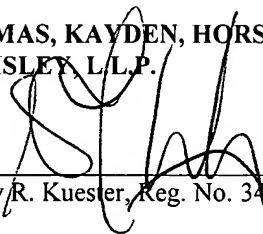
As cited in attached form PTO-1449, the Applicants for the present invention include inventors whose company (Acterna, LLC) contracted with BellSouth to provide their services to BellSouth in writing software included in the present application. Applicants respectfully assert that this contracting agreement does not trigger the on-sale bar even though an agreement was in place more than one year prior to the filing of the present application.

It is requested that the information disclosed herein be made of record in this application and that the Examiner initial and return a copy of the enclosed PTO-1449 to indicate the documents have been considered.

Respectfully Submitted,

**THOMAS, KAYDEN, HORSTEMEYER
& RISLEY, L.L.P.**

By:



Jeffrey R. Kuester, Reg. No. 34,367

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Customer No.: **38823**

190250-1480

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INFORMATION DISCLOSURE CITATION

Lyles, et al.

December 5, 2003

2681

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(Use several sheets if necessary)

U.S. PATENT DOCUMENTS

[illegible]

FOREIGN PATENT DOCUMENTS

[illegible]

OTHER DOCUMENTS (Including Author, Title, Date, Pertinent Pages, etc.)

	A	User Guide: BTAS User Documentation, unpublished (see Applicants' statement in IDS for further information); (51 pages)
	B	Applicants' statement in IDS regarding agreement between BellSouth and Acterna, made more than one year prior to the filing date of the present application

* EXAMINER: Initial if citation considered, whether or not citation is in conformance with MPEP § 609. Draw line through citation if not in conformance and not considered. Include copy of this form with next communication to the applicant.

EXAMINER'S SIGNATURE:

DATE CONSIDERED: